

Appl. No. 09/989,313
Reply to Office Action of June 24, 2003
Page 7

REMARKS

As a result of the above amendments, claims 1, 9, and 18 have been amended, claims 5, 7, 8, 13, 16, 17, and 24-39 have been canceled, and claims 40-60 have been added (no new matter has been added). Consequently, claims 1-4, 6, 9-12, 14, 15, 18-23, and 40-60 are at issue.

CLAIM REJECTIONS - 35 U.S.C. §102

In paragraph three of the Office Action, the Examiner rejected claims 9-12, 14, 15, and 18-39 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,782,165 to Glenboski et al. ("Glenboski"). Applicant respectfully traverses this rejection.

The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *Ex Parte Levy*, 1990 Pat. App. LEXIS 18, *3, 17 U.S.P.Q. 2d 1461 (BPAI 1990); *In re Lange*, 209 U.S.P.Q. 288 (CCPA 1981) (in order to anticipate, the reference must describe or disclose all of the limitations of the claims). It is well-settled law that the burden of establishing a prima facie case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 1986 Pat. App. LEXIS 4, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

Amended claim 9 is directed to a cooking device for use within a cooking chamber of a barbecue grill and requires a *generally annular top wall*; a central portion recessed from the top wall, the central portion having a curvilinear cooking surface; and, *a flange extending from the top wall*, the flange configured to engage an inner surface of the cooking chamber and support the cooking device in the cooking chamber.

Glenboski does not anticipate amended independent claim 9 for at least two reasons. First, Glenboski does not disclose or suggest a generally annular top wall. Referring to Figures 1B & 2A, the tray 22 has a top wall 106 with a generally rectangular configuration. The top wall 106 is not annular or ring-shaped as that term is used in Applicant's disclosure (see Figures 2-4). Second, Glenboski does not disclose or suggest a flange. Consistent with Applicant's disclosure (see pages 6-7 and Figures 2-5), a flange is a structure that extends from the top wall of the cooking device. Glenboski merely discloses a tray 22 with a top wall 106 that lacks the required flange. In fact, no structure extends from the top wall 106 of Glenboski's tray 22. For each of these reasons, Glenboski does not anticipate or suggest amended claim 9 and the claim is patentably distinct.

Appl. No. 09/989,313
Reply to Office Action of June 24, 2003
Page 8

Claims 10-12, 14, and 15 depend from amended independent claim 9 and therefore require the elements of claim 9. For the reasons explained with respect to that claim, claims 10-12, 14, and 15 are neither anticipated by nor rendered obvious by Glenboski.

Amended independent claim 18 is directed to an outdoor cooking assembly and comprises a barbecue grill assembly having a cooking chamber and a mating lid, the cooking chamber having a heat source positioned in a lower portion of the cooking chamber; a cooking pan removably positioned within the cooking chamber, the cooking pan having a curvilinear central portion with a cooking surface, the cooking pan having a flange extending from an outer edge of the central portion, the flange having an engaging surface; and, *at least one support member positioned on an inner surface of the cooking chamber*, wherein the support member engages the flange engaging surface to support the cooking pan within the cooking chamber.

Although the Examiner provided his interpretation of Glenboski, the Examiner failed to identify any structure in Glenboski that allegedly corresponds to the claimed support member of the cooking chamber. Thus, the Examiner has not established the prima facie case of anticipation of claim 18. *Ex Parte Skinner*, 1986 Pat. App. LEXIS 4, 2 U.S.P.Q. 2d 1788 (BPAI 1986). Applicant submits that the prima facie case of anticipation cannot be established because Glenboski does not disclose or suggest a support member positioned on an inner surface of the cooking chamber that engages the flange engaging surface to support the cooking pan within the cooking chamber. A close review of Figs. 2A, 2B, 4 and 6 shows that Glenboski's tray 22 nests within pan 60 wherein the top wall 106 "rests upon support surface 82 of pan 60." See Glenboski, col. 4, lns. 10-15. Since the pan 60 is structurally distinct from the cooking chamber 32, the tray 22 engages and is supported by the pan 60 and not by a support member of the cooking chamber 32 as required by claim 18. Consequently, Glenboski does not anticipate or suggest independent claim 18 and the claim is patentably distinct.

Claims 19-23 depend from amended independent claim 18 and therefore require all elements of claim 18. For the reasons explained with respect to that claim, claims 19-23 are neither anticipated by nor rendered obvious by Glenboski.

Appl. No. 09/989,313
Reply to Office Action of June 24, 2003
Page 9

CLAIM REJECTION - 35 U.S.C. §103

In paragraph five of the Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. §103 as allegedly obvious in view of Glenboski and U.S. Patent No. 5,363,977 to Hoff ("Hoff"). Applicant respectfully traverses this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden on factually supporting any prima facie conclusion of obviousness. See MPEP § 2142; *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion or motivation to combine Glenboski with Hoff. Glenboski and Hoff are directed to entirely distinct devices. Glenboski discloses a cooking apparatus with a plurality of nested cooking surfaces (the trays 22, 24 and the pan 60), whereas Hoff discloses a combination cooker and cooler with a single cooking surface (the pot 36). On page 5 of the Office Action, the Examiner proffers an explanation regarding the combination of Glenboski and Hoff and resulting modifications to Glenboski. However, that explanation appears to be formulated on hindsight reconstruction gained after review of Applicant's disclosure. *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from the prior art absent some suggestion or motivation in the prior art itself to do so).

As another grounds for overcoming the obviousness rejection, Applicant notes that when the proposed combination of references changes the principle of operation of either reference, then the teachings of the references are not sufficient to render the claims prima facie obvious. See MPEP 21431.02; *In re Ratti*, 123 USPQ 349 (CCPA 1959). Here, the Examiner has attempted to combine the teachings of the secondary reference, Hoff, with Glenboski without fully considering the ramifications. Glenboski's disclosure is premised on the fact that the trays 22, 24 nest within the pan 60 and are supported therein by the support surface 82 of the pan 60. As shown in Fig. 4, the pan 60 (and the nested trays 22, 24) is then positioned within the housing 32 and supported therein by

Appl. No. 09/989,313

Reply to Office Action of June 24, 2003

Page 10

the bosses 76, the support pads 48, and a gasket 94 located between the flange 80 of the pan 60 and the lip 42 of the housing 32. See Glenboski, col. 3, lns. 55-67. The modification suggested by the Examiner - - to add an annular flange on the tray 24 "...to match the shape of the outer housing in order to render the device portable" - - would add unnecessary structure to the trays 22, 24, the pan 60, and the housing 32. Furthermore, one of ordinary skill recognizes that adding an annular flange to the tray 24 would severely comprise the nesting of the trays 22, 24, the pan 60, and the housing 32 and render Glenboski inoperable. Because the Examiner's proposed combination of Glenboski and Hoff dramatically changes the structure and operation of the primary reference, the prima facie case of obviousness has not been established.

As an additional ground for reversing the Section 103 rejection, Applicants submit that the combination of Glenboski and Hoff does not disclose or suggest all limitations of claims 1-4 and 6. Amended independent claim 1 is directed to a cooking device for use with a cooking chamber of a barbecue grill, and requires a curvilinear central portion having a cooking surface; and, *an annular flange depending from an outer portion of the central portion*, the flange adapted to engage an inner surface of the cooking chamber and support the cooking device above a heat source positioned in a lower portion of the cooking chamber. Neither Glenboski nor Hoff disclose an annular flange depending from the central portion of the cooking device. As explained above, Glenboski's tray 22 has a top wall 106 but lacks the required depending flange. Referring to the basic image shown in Fig. 1A, Hoff's cooking pot 36 has a top wall (not labeled) but lacks the required depending flange. Consequently, the combination of Glenboski and Hoff neither discloses nor suggests all of the limitations of amended claim 1 and as a result, this claim is patentably distinct.

Claims 2-4 and 6 depend from amended independent claim 1 and therefore require all elements of claim 1. For the reasons explained with respect to that claim, claims 2-4 and 6 are not rendered obvious and are patentably distinct.

ADDED CLAIMS

Applicant has added claims 40-60 and submits that each claim is fully supported by Applicant's disclosure and does not introduce any new matter.

Independent claim 40 is directed to a cooking device for use with a cooking chamber of

Appl. No. 09/989,313

Reply to Office Action of June 24, 2003

Page 11

a barbecue grill and requires, among other things, at least one extendable handle operably connected to an annular top wall. Independent claim 47 is directed to a cooking device for use with a cooking chamber of a barbecue grill and requires, among other things, a flange that depends from a top wall wherein the flange has an outer rim that is positioned radially outward from the top wall and wherein the rim is configured to engage an inner surface of the cooking chamber. Independent claim 57 is directed to an outdoor cooking assembly and requires, among other things, a cooking pan having a generally annular top wall and a flange depending from the top wall wherein flange has an engaging surface, the cooking pan further having at least one collapsible handle connected to the top wall; and, at least one support tab of the cooking chamber that engages a portion of the flange engaging surface to support the cooking pan within a cooking chamber of the outdoor cooking assembly. Applicant submits that all of the added claims are patentably distinct over the art of record.

SEP. 24. 2003 6:03PM

WALLENSTEIN WAGNER

RECEIVED 0.5658 P. 17
CENTRAL FAX CENTER

SEP 25 2003

Appl. No. 09/989,313
Reply to Office Action of June 24, 2003
Page 12

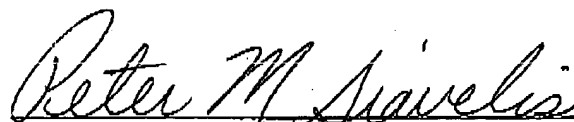
CONCLUSION

Based on the foregoing, Applicants submit that the pending claims are in a condition for allowance and respectfully request an early notice of the same. The Examiner is invited to call the undersigned if any issues can be resolved through a telephonic interview.

Respectfully submitted,

Dated: September 24, 2003

By:



Peter M. Siavelis, Reg. No. 51,136
Wallenstein Wagner & Rockey, Ltd.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312.554.3300

CERTIFICATE OF FACSIMILE (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being facsimile transmitted to Examiner Josiah C. Cocks, Group 3743, at the U.S. Patent and Trademark Office to Fax No. 703/872-9302 with a confirming facsimile transmittal to 703/308-7764 on September 24, 2003.



Peter M. Siavelis/184007.1

OFFICIAL